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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/747,612	12/30/2003	Phillip Ace McCoppin	201818-0307164	2890
909 7590 08/13/2008 PILLSBURY WINTHROP SHAW PITTMAN, LLP P.O. BOX 10500 MCLEAN, VA 22102				
EXAMINER				
BAIRD, EDWARD J				
ART UNIT		PAPER NUMBER		
3693				
MAIL DATE		DELIVERY MODE		
08/13/2008		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/747,612

Applicant(s)

MCCOPPIN ET AL.

Examiner

Ed Baird

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 June 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-24 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-946)
- 3) ☐ Information Disclosure Statement(s) (PTO/SF/ICE)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 20 June 2008 has been entered.

Status of Claims

2. Applicant has amended claims 2, 3, 7, 10-12, 14, 15, 19, and 22 – 24. No new claims have been added or canceled. Thus, claims 1 – 24 remain pending and are presented for examination.

Response to Arguments

3. Applicant's arguments and amendments filed on 20 June 2008, with respect to rejections of claims 2 – 3, 7, 10 – 12, 14 – 15, 19, and 22 – 24 rejected under 35 U.S.C. § 112, second paragraph, claims 1, 5, 6, 8, 9, 13, 17, 18, 20, and 21 rejected under 35 U.S.C. § 102(b), and claims 2, 3, 7, 10 – 12, 14, 15, 19, and 22 – 24 rejected under 35 U.S.C. § 103 (a) have been fully considered.

4. Examiner acknowledges Applicant's amendments to claims 2 – 3, 7, 10 – 12, 14 – 15, 19 and 22 – 24 in attempt to overcome rejections under 35 U.S.C. § 112, second paragraph.

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Examiner notes that in each of these claims, except claim 22, adds additional indefinite language to the claim and thus necessitates new rejections under 35 U.S.C. § 112, second paragraph as noted below.

Applicant cites US Patent Application Publication US 2005/0144128 as support for the use of terms such as FEDWIRE as acceptable terminology in US Patents (Amendment page 6, last paragraph and page 7, 1st paragraph). Examiner notes that even if terms such as FEDWIRE are used in the specification of a US Patent Application Publication, it is not necessarily allowed in the claim language.

5. Applicant's arguments with respect to claims 1 – 24 have been considered but are moot in view of the new ground(s) of rejection.
6. Examiner notes that in *Discussion of Harada and its Deficiencies* (Amendment page 8, 1st paragraph), Applicant argues stating "as recited in independent claim 1, as amended (emphasis added)". Examiner notes claim 1 has not been amended.

Claim Rejections - 35 USC § 112

7. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

8. Claims 2, 3, 7, 11, 12, 14, 15, 19, 23 and 24 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
9. **Claims 2, 3, 7, 11, 12, 14, 15, 19, 23 and 24** recite in the limitations "useful for something". "Being useful" is not further limiting the claim. This can be exemplified in claim 2

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which states: "useful for carrying out domestic funds transfers"; being useful for carrying out domestic funds transfers does not indicate a domestic fund transfer is made.

For purposes of examination, the phrase starting with "useful for" will be interpreted to be not further limiting. Appropriate correction is required.

Claim Rejections - 35 USC § 102

10. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

11. Claims 1 – 3, 5 – 15, and 17 – 24 are rejected under 35 U.S.C. 102(e) as being anticipated by **Lawrence** (USPub. No. 2003/0233319).

12. Regarding **claims 1 and 13**, **Lawrence** teaches:

- receiving financial transaction payment instructions from a Client Bank in a format associated with a settlement funds transfer system that provides guaranteed funding of the transaction to a Receiver Financial Institution [see at least Abstract, 0022 – 0024, and Figure 1]. Examiner interprets financial institution as including Applicant's Client Bank and Receiver Financial Institution. Examiner notes that these financial institutions include "*any insured bank*" thus being indicative of Applicant's **guaranteed funding of transactions**.
- analyzing the received financial transaction payment instructions [see at least 0030, 0032 and 0057]. Examiner interprets a *risk management clearing house (RMC)* which

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"gathers data, ... and relates the data to risk variables for the purpose of managing risk associated with a risk variable" as analogous to Applicant's analyzing **payment instructions**.

- generating foreign financial transaction payment instructions for at least one financial institution located in a foreign country, the foreign financial transaction payment instructions including data in a funds transfer messaging service format that is compatible with both the Receiver Financial Institution and the at least one financial institution [see at least 0031 and 0033]. Examiner notes that *financial institutions* [0024] include foreign banks and foreign financial agencies.

13. Regarding **claims 2 and 14, Lawrence** teaches:

- wherein the settlement funds transfer system comprises a U.S. Federal Reserve Bank funds transfer system useful for carrying out domestic funds transfers [0029],
- wherein the financial transaction payment instructions cause both an automatic credit and an automatic debit of associated accounts to be made upon receipt [see at least 0041 and 0042].

14. Regarding **claims 3 and 15, Lawrence** teaches:

- wherein the funds transfer messaging service format that is compatible with both the Receiver Financial Institution and the at least one financial institution is compatible with a world-wide financial messaging network comprising standardized messaging services and interface software useful for initiation of international payments [see at least 0002, 0023, and 0029]. Examiner notes that SWIFT ("Society for Worldwide Interbank Financial Telecommunication") is an example of Applicant's **world-wide financial messaging network**.

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15. Regarding **claims 5 and 17, Lawrence** teaches the Client Bank as a domestic bank [0024].
16. Regarding **claims 6 and 18, Lawrence** teaches the financial transaction is self funding [see at least 0023 and 0024].
17. Regarding **claims 7 and 19, Lawrence** teaches:
 - the financial transaction payment instructions are received via an interface with the settlement funds transfer system, said interface being configured to provide access to a U.S. Federal Reserve Bank funds transfer system useful for carrying out domestic funds transfers [see at least 0024].
18. Regarding **claims 8 and 20, Lawrence** teaches:
 - transmitting the foreign financial transaction payment instructions to the at least one financial institution [see at least 0024].
19. Regarding **claims 9 and 21, Lawrence** teaches:
 - the at least one financial institution includes a branch of the Receiver Financial Institution that generated and transmitted the foreign financial transaction payment instructions [see at least 0026 and 0027].
20. Regarding **claims 10 and 22, Lawrence** teaches:
 - the at least one financial institution includes a member of a non-Federal Reserve Bank electronic payments system [see at least 0024].
21. Regarding **claims 11 and 23, Lawrence** teaches:
 - the at least one financial institution includes a member of a U.S. Federal Reserve Bank funds transfer system useful for carrying out domestic funds transfers [see at least 0023],

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- wherein the financial transaction payment instructions cause both an automatic credit and an automatic debit of associated accounts to be made upon receipt thereof receipt [see at least 0041 and 0042].
22. Regarding **claims 12 and 24**, **Lawrence** teaches:
- the at least one financial institution includes a correspondent bank that is connected to the Receiver Financial Institution that generated and transmitted the foreign financial transaction payment instructions via a world-wide financial messaging network [see at least 0023 and 0029]
 - comprising standardized messaging services and interface software useful for initiation of international payments [see at least 0067 and 0068],
 - the correspondent bank handling business in a particular geographic area [see at least 0002 and 0051].

Claim Rejections - 35 USC § 103

23. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

1. Claims 4 and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Lawrence** in view of **SWIFT.com** ("MT 103 migration – a success for the whole community", home page stories archive 2003, posted 11/21/2003).

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2. Regarding **claims 4 and 16**, **Lawrence** teaches all the items of claims 2 and 14, the claims upon which these claims depend, respectively, but do not teach foreign financial transaction payment instructions which comply with SWIFT MT 103 specifications (i.e. messaging standards).

However, **SWIFT.com** teaches about foreign financial transaction payment instructions which comply with SWIFT MT 103 messaging standards. **SWIFT.com** discloses "The weekend of 15-16 November saw two significant events in SWIFT's history. The first was the removal of the MT 100, SWIFT's most-used message, from the network. To enable this to happen, migration to the MT 103 needed a successful completion and this was achieved with a 98% migration rate on the last working day before the deadline", [2nd paragraph].

Therefore, it would have been obvious to a person having an ordinary skill in the art at the time of **Lawrence's** disclosure to include *SWIFT MT 103 specifications* as disclosed by **SWIFT.com** because its use would increase certainty, transparency, and automation (STP) of customer transfers as well as reduced cost, reduced risk, and conform to worldwide regulatory requirements.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ed Baird whose telephone number is (571) 270-3330. The examiner can normally be reached on Monday - Thursday 7:30 am - 5:00 pm Eastern Time.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jay Kramer can be reached on (571) 272-6783. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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